



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,699	01/09/2002	Carl R. Jacobs	52646-403USP	7699

26231 7590 07/28/2004

FISH & RICHARDSON P.C.
5000 BANK ONE CENTER
1717 MAIN STREET
DALLAS, TX 75201

EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,699

Applicant(s)

JACOBS ET AL.

Examiner

Igor Borissov

Art Unit

3629



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-24. Claims include method steps while referring to a system.

Claim 8. The phrase "*the identity of the user*" lacks antecedent bases.

Claim 11. The phrase "*the vehicle information*" lacks antecedent bases.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Struthers et al. (US 2003/0075600).

Struthers et al. (hereinafter Struthers) teaches a method and system for fuel dispenser having a guided customer transaction interface, comprising:

Claim 1. Fuel dispenser; a user interface; a display; and a controller which is operably coupled to the fuel dispenser and adapted to determine a manner in which a user will pay for said fuel, and further adapted to display information on the display as a function of the manner in which the user will pay for said fuel; wherein at least a portion

of the display information is unrelated to the manner in which the user will pay to dispense fuel [0011]; [0045]; [0048] - [0050].

Claim 2. A network interface operably coupled to the controller and connectable to one or more programming providers; and wherein the controller is adapted to obtain at least some of the displayed information from one or more of the programming providers [0045]; [0048] – [0050].

Claim 3. Said system as in claim 2, wherein a plurality of programming providers are operably coupled to the network interface; and wherein the controller is adapted to obtain at least some of the displayed information from a plurality of the programming providers [0045]; [0048] – [0050].

Claim 4. Said system, wherein said information is selected from the group consisting of advertising and Internet access [0045]; [0048] – [0050].

Claim 5. A computing system for use with a fuel dispensing system including fuel dispensing equipment, a user interface, and a display, further including: a medium for storing software instructions; said instructions are stored on the medium for: determining a manner in which a user of the system will pay to dispense fuel; obtaining information from one or more remote sources of information; and displaying the information on the display as a function of the manner in which the user will pay to dispense the fuel; wherein at least a portion of the information is unrelated to the manner in which the user will pay to dispense the fuel [0011]; [0045]; [0048] - [0050]. Using a computer for performing said functions inherently indicates using a medium for storing instruction for performing said functions.

Claim 6. Said system as in claim 5, including instructions stored on the medium for obtaining the displayed information from a plurality of remote sources of information [0045].

Claim 7. Said system as in claim 5, including instructions stored on the medium for obtaining the displayed information from a plurality of remote sources of information [0045]; [0048].

Claim 8. Means for obtaining at least some of the information from a plurality of remote sources of information; and selecting a subset of the information for display, according to the identity of the user [0058] – [0059].

Claims 9 and 10. Means for displaying information on the display as a function of the identity of the customer, customer's purchasing history and loyalty of the customer [0058] – [0059]. Information as to *preferred* customer is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 11. Means for displaying information related to a vehicle of the user [0050].

Claim 12. See claim 11. Information as to *warranty information, servicing information, and manufacturer recall information for the customer's vehicle* is non functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 13. Means for displaying information on the display as a function of the display preferences for the user [0049].

Claims 14-19. A database comprising customer related information, including customer identifiers, sales history and product preferences [0058] – [0059]. The *specifics* of the customer related information is non-functional language and given no patentable weight. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 20. Said system, wherein the customer data includes display preferences for the user [0049].

Claim 21. Means for retrieving one of the customer records associated with the user; and means for processing the associated customer record to determine what to display on the display [0058] – [0059].

Claims 22-23. Said system as in claim 7, wherein said information is selected from the group consisting of advertising and Internet access [0045]; [0048] – [0050]. Information as to *warranty information, servicing information, and manufacturer recall information* is non-functional language and given no patentable weight. The specifics of the customer related information is non-functional language and given no patentable weight. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 24. Means for determining an identity of a user [0058]. Information as to *determining that the user fits a profile for generalized identification of customers* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The closes foreign art uncovered by the examiner: EP 1102221 A2 to Symonds, disclosing a fuel dispenser equipped with means to display an advertising slide show.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

Art Unit: 3629

Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

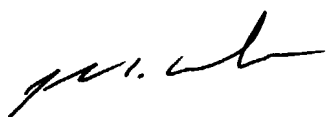
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600